

REMARKS

Claim 1 was pending in the subject application. Applicant has hereinabove added new claims 2-13. Accordingly, upon entry of this Amendment claims 1-13 will be pending and under examination.

Applicant maintains that these amendments to the claims do not raise any issue of new matter, and that these claims are supported by the specification as originally filed.

Objection to the Drawings

In the July 8, 2008 Office Action, the Examiner objected to the drawings, stating that the rings "arranged in adjacent rows in opposite alignment" must be shown or the feature(s) canceled from the claim, and that no new matter should be entered.

In response to the Examiner's objection, applicant has canceled claim language stating that the rings are "arranged in adjacent rows" and submitted replacement sheets for Figs. 1 and 2. In particular, applicant has specifically pointed out the magnetism inherently associated with aligning both opposing or attractively charged magnetic balls and rings. As known in the art, and

discussed below in more detail, items that are magnetized inherently possess both a negative and positive pole. Therefore, as can be seen from new Fig. 1, attractive alignment refers to the arrangement of a negative pole from one ball, being placed juxtaposition to a positive pole in the adjacent ball, such that there is a magnetic attraction and an ensuing magnetic field. Conversely, as can be seen from new Fig. 2, opposite alignment refers to the arrangement of a negative pole from one ball, being placed next to a negative pole in the adjacent ball, such that there is a magnetic repulsion.

Applicants maintain that these replacement drawings do not contain any new matter, and that this replacement drawing is supported by the specification as originally filed.

Accordingly, applicant respectfully requests the Examiner to remove these objections to the drawings.

Rejection Under 35 U.S.C. §112, First Paragraph

In the July 8, 2008 Office Action, the Examiner rejected claim 1 under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the enablement requirement. Specifically, the Examiner allegedly stated that the

specification of the instant application fails to describe how a pulsating magnetic field is generated by the magnetized or magnetisable balls or rings. Furthermore, the Examiner stated that the specification is not enabling with respect to how the rings are arranged "in adjacent rows" given that the drawings lack rows.

In response to the Examiner's rejection, applicant states the creation of a magnetic field from oppositely charged magnetic elements is known in the art and inherent from the specification as filed. In particular, it is known that permanent magnets are objects that produce their own persistent magnetic fields, and as such all permanent magnets have both a north and a south pole. Thereby, like poles repel and opposite poles attract as is inherent in physics. Furthermore, the magnetism in a permanent magnet arises from properties of the atoms (in particular the electrons) that compose it; each atom acts like a little individual magnet. If these magnets line up, they combine to create a macroscopic magnetic effect.

In addition, replacement Figs. 1 and 2 clearly illustrate the magnetized balls and rings within the inert tube of the annularly shaped element as properly set out and described

in the specification. As described above, by placing the balls in an attractive alignment, (i.e. placing the negative pole of one magnet adjacent to the positive pole of another magnet) a magnetic field will be created. Thereby, having the balls or rings arranged in the respective orientations (i.e. attractive or opposite), the pulsating magnetic field is generated; the force may be attractive or repellant based on the alignment within the inert tube.

In view of the applicant's remarks and amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

Rejection Under 35 U.S.C. §112, Second Paragraph

In the July 8, 2008 Office Action, the Examiner rejected claim 1 under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that it is unclear as to what defines "an attractive alignment" or "opposite alignment".

In response to the Examiner's rejection, applicant respectfully traverses on the ground that support in the specification can be found for the claims, as amended, specifically for the above-referenced phrase.

In particular, applicant has specifically pointed out the magnetism associated with attractive and opposite alignment. As known in the art, and discussed below in the specification in great detail, items that are magnetized possess both a negative and positive pole. Therefore, as can be seen from new Fig. 1, and in no way an admission that these characteristics were not recognizable prior, at very least, but not limited to inherently attractive alignment refers to the arrangement of a negative pole from one ball, being placed next to a positive pole in the adjacent ball, such that there is a magnetic attraction. Conversely, as can be seen from new Fig. 2, opposite alignment refers to the arrangement of a negative pole from one ball, being placed juxtaposition to a negative pole in the adjacent ball, such that there is a magnetic repulsion.

In view of the applicant's remarks and amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

Rejection under 35 U.S.C. §101

In the July 8, 2008 Office Action, the Examiner rejected claim 1 under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Furthermore, the Examiner allegedly states that such features of the invention would not produce any effect such that a therapeutic benefit would be induced upon a subject.

In response to the Examiner's rejection, applicant states that the invention has been in use for years and has been successfully applied to individuals in relieving medical complaints stated in the specification. Furthermore, applicant has attached two declarations to this amendment that attest to the utility and functionality of the instant invention.

In addition to relying on the attached declaration, applicant reiterates that the usefulness of the invention is mentioned in the specification above; the fact that the invention is able to relieve individuals pain for the complaints stated, speaks to the usefulness of the invention (see Decl. Zimmerman, pg. 2 ¶6). Moreover, the guidelines for a utility rejection based upon "inoperative" inventions, clearly state under **MPEP 2107.01 II**, that "A small degree of utility is sufficient . . . The claimed invention must only be capable of performing some beneficial

function . . . In short, the defense of non-utility cannot be sustained without proof of total incapacity" (*E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17).

Furthermore, under **MPEP 2107.01 III**, regarding therapeutic benefits, courts have held that ". . . where the mode of operation alleged can be readily understood and conforms to the known laws of physics and chemistry, operativeness is not questioned, and no further evidence is required" (*In re Gazave*, 379, F.2d 973, 978).

Lastly, with respect to the Examiner's allegations and conjectures concerning that "pulsating magnetic field therapy relies upon the use of a coil and signal generator in order to produce a therapeutic magnetic field", on what basis does the Examiner make this conclusion. Furthermore, why does a pulsating magnetic field therapy only rely upon the use of a coil and signal generator? Again, what evidence does the Examiner possess to support these allegations?

Moreover, on what basis does the Examiner make the claim that the instant invention would not provide any therapeutic benefit? It is inappropriate for the Examiner to make statements

regarding medical treatment and opinions if the Examiner does not possess the requisite background to make those opinions.

Therefore, as illustrated in the attached declaration, the applicant has seen tangible and useful results from the application of the invention to those individuals suffering from the medical problems stated in the specification.

In view of the applicant's remarks and amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

Rejection under 35 U.S.C. §102(b)

In the July 8, 2008 Office Action, the Examiner rejected claim 1 under 35 U.S.C. 102(b) as being anticipated by Ansari (U.S. Patent No. 3,805,777). The Examiner alleges that Ansari teaches an interuterine device comprising a ring embedded with magnets. Regarding claim 1, Ansari discloses a device in the form of a ring, also made of an inert, elastically deformable material. Furthermore, the Examiner states that magnetic rings segments, or "magnetized balls," are introduced into the ring and are arranged in opposite alignment. Lastly, the Examiner states that the device is capable of being placed within the vagina or uterine cavity.

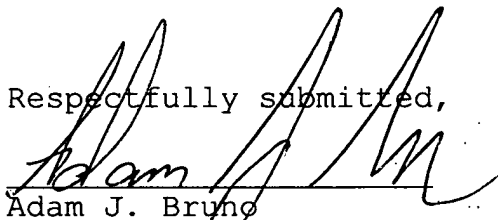
In response to the Examiner's rejection, applicant respectfully traverses on the grounds that U.S. Patent No. 3,805,777 to Ansari does not teach each and every limitation of applicant's invention.

First, unlike Ansari, the placement is of the rings or balls in the instant invention are not random, but rather aligned in a specific orientation based on the desired result. As stated above, the placement of a negative pole of one magnet next to the positive pole of an adjacent magnet creates attractive forces between the two magnets, thereby giving an attractive alignment. Conversely, Ansari is silent on the orientation of the magnets within the device; the only description set forth regarding the magnets is with respect to the spacing. Specifically, Ansari states in column 3, lines 45-49, "The critical aspect of the invention is that the segments are spaced sufficiently far apart, with sufficient intervening silico-organic rubber material, to render the device readily deformable". This limitation recited in Ansari, is not needed in the instant invention, rather there is no spacing between the rings or balls, conversely, it is the placement of the rings or balls side-by-side that provides the therapeutic benefits to individuals.

In view of the applicant's remarks and amendments to the claims, applicant respectfully requests the Examiner to remove this ground of rejection.

No fee is deemed necessary in connection with the filing of this Amendment. If any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account 12-0115.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Adam J. Bruno", is written over a horizontal line.

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Amendments to the Drawings

Please replace Figures 1-2 of the subject application with replacement Figures 1-2 attached as **Exhibit A**.